

Serial No. 10/532,342  
Docket No. SNK-001-US

12

(IWA.031)

**REMARKS**

Claims 1 and 3-28 are all the claims presently pending in the application. Claim 2 has been cancelled. Claims 1, 3-14, 16-17, and 23-28 have been amended to more particularly define the invention.

No new matter is added.

Applicant notes that the Examiner appears to be relying on an English language translation of the Sanko reference (Office Action at page 7, first paragraph). If so, in order to enable Applicant to provide an accurate response to the Examiner's rejections, Applicant respectfully requests that the Examiner provide Applicant with a copy of this English language translation.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Entry of this § 1.116 Amendment is proper. Since the Amendments above narrow the issues for appeal and since such features and their distinctions over the prior art of record were discussed earlier, such amendments do not raise a new issue requiring a further search and/or consideration by the Examiner. As such, entry of this Amendment is believed proper and Applicant earnestly solicits entry.

Claims 1, 4, 17, 19, 25, and 26 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite.

With respect to the prior art, claims 1, 3, 5, 14-17, and 24 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Cahoon (U.S. Patent No. 5,535,567) in view of Sanko (JP 2000-314211). Claims 4 and 18-23 stand rejected under 35 U.S.C. § 103(a) as being

Serial No. 10/532,342  
Docket No. SNK-001-US

13

(IWA.031)

allegedly unpatentable over Cahoon in view of Sanko and further in view of McCoy (U.S. Patent No. 2,038,437). Claims 25-28 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Cahoon in view of Sanko and further in view of Greenberg (U.S. Patent No. 5,247,772).

The rejections mentioned above are respectfully traversed in the following discussion.

## I. THE CLAIMED INVENTION

An exemplary aspect of the claimed invention (e.g. as recited in claim 1) is directed to an outer surrounding body for use in construction that includes a plurality of construction sheets having a thin metal sheet part and a synthetic resin film formed on a top portion of the thin metal sheet part, the plurality of construction sheets including a main sheet part, an overlapped part formed on an end in a width direction of the main sheet part, the overlapped part including a hairpin fold, and a fastening part formed flat on an outside end of the overlapped part, an engaged part formed in said hairpin fold of the overlapped part, an engaging part, formed on an other end in the width direction of the main sheet part, for engaging and fastening an engaged part of a first adjacent construction sheet of the plurality of construction sheets, and an overlapping part formed to overlap with an overlapped part and a fastening part of the first adjacent construction sheet. The plurality of construction sheets are disposed side by side, such that the overlapping part of a second adjacent construction sheet of the plurality of construction sheets is placed on the fastening part, overlaps the overlapped part, and engages the engaged part. The synthetic resin film is fused around an outer end of the overlapping part of the second adjacent construction sheet and an inside corner of the overlapped part. The plurality of construction sheets overlap each other. An edge of an outer end of the fastening part is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part.

Serial No. 10/532,342  
Docket No. SNK-001-US

14

(IWA.031)

Conventional roofing materials have always strived to achieve water-tightness or waterproofing. However, conventional materials possess significant drawbacks. Roofing materials using connecting structures to connect pieces together securely need to be filled with a sealing material in order to achieve waterproofing (Application from page 1, paragraph 2 to page 2, paragraph 1). Even then, the sealing material will deteriorate significantly in both aesthetics and waterproofing functionality after long-term use (Application at page 2, paragraph 1). Other conventional roofing materials utilize resin welding and molten resin material in order to provide waterproofing for a roof (Application at page 3, paragraph 1). These materials suffer from several drawbacks, including the sheet material being deformed aesthetically and functionally by the molten resin material and a lack of adhesion of the molten resin material to the sheet material (Application at page 3, paragraphs 1-3). In addition, application of the molten resin material requires individuals who have significant experience with the specific material to guard against aesthetic and functional defects (Application at page 5, paragraph 1).

On the other hand, the aforementioned exemplary aspect of the claimed invention may include an outer surrounding body for use in construction where an edge of an outer end of the fastening part is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part (Application at page 23, first paragraph). This feature may provide an outer surrounding body for use in construction which is able to prevent deformation by large accumulations of snow (Application at pages 23, last two lines of page).

## II. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claims 1, 4, 17, and 19 are indefinite. The Examiner also alleges that claim 1 is incomplete. Further, the Examiner alleges that claims 25 and 26 are unclear.

Serial No. 10/532,342  
Docket No. SNK-001-US

15

(IWA.031)

While Applicant respectfully submits that one of ordinary skill in the art would certainly understand the metes and bounds of claims 1, 4, 19, and 25-26, to expedite prosecution, Applicant notes that claims 1, 4, 19, and 25-26 have been amended to address the Examiner's concerns. Specifically, claim 1 has been amended to address the Examiner's concerns regarding antecedent basis and structural omission. Claims 4 and 19 have been amended to address the Examiner's indefiniteness concerns. Also, claims 25 and 26 have been amended to address the Examiner's concerns regarding clarity.

However, Applicant respectfully submits that claim 17 particularly points out and distinctly claims the subject matter which Applicant regards as the invention. Indeed, this particular subject matter is clearly supported at page 8, second paragraph of the Application ("resin welding . . . in the connection locations").

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

### III. THE PRIOR ART REJECTIONS

#### A. The Alleged Cahoon and Sanko Combination

Cahoon discloses an interlocking roofing panel (Cahoon at Abstract). Sanko discloses a building material structure in which individual materials are joined together (Sanko at Abstract). The Examiner alleges that Cahoon and Sanko can be combined to make the invention of claims 1-3 and 5 obvious.

However, Applicant respectfully submits that Cahoon and Sanko would not have been combined by one of ordinary skill in the art. Specifically, the interval structure of Sanko combined with the clip structure of Cahoon would leave Cahoon unsatisfactory for its intended purpose and would radically change the principal of operation of Cahoon. Therefore, one of ordinary skill in the art would not have combined Cahoon and Sanko.

Serial No. 10/532,342  
Docket No. SNK-001-US

16

(IWA.031)

Further, even assuming (*arguendo*) Cahoon was combined with Sanko, the resultant combination would clearly fail to teach or suggest an outer surrounding body for use in construction "wherein an edge of an outer end of the fastening part is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part", as recited, for example, in claim 1 (Application at page 23, first paragraph). This feature may provide an outer surrounding body for use in construction which is able to prevent deformation by large accumulations of snow (Application at pages 23, last two lines of page).

The Examiner admits that neither Cahoon nor Sanko – even assuming (*arguendo*) combination – teaches or suggests this feature of the claimed invention, by stating “[t]he fastening part edge is not expressly disclosed as bent backward” (Office Action at page 6, second paragraph). The Examiner alleges that, despite admitting the non-existence of the feature in Cahoon, Sanko, or the alleged combination of the two, “such a backward bend is considered a matter of design choice, as both edges serve the same function of providing an alternate surface (apart from the fastener head) onto which the underside of the panel is disposed” (Office Action at page 6, second paragraph).

However, Applicant specifically states on page 23 of the Application that,

[i]n particular, in cases where a bent end edger 4a is formed on the outer end of the fastening part 4, the back surface of the main sheet 1 of the adjacent construction sheet A contacts the top part of the abovementioned bent end edge 4a. In this state, as is shown in Fig. 1B, the configuration can be arranged so that the head parts of the fastening fittings 12 such as screws or the like that fasten the fastening part 4 to the underlying part 5 do not contact the main sheet 1. Furthermore, deformation of the main sheet 1 by accumulated snow can be prevented

(emphasis added).

Thus, Applicant respectfully submits that the Examiner is in clearly incorrect when asserting that an edge of an outer end of the fastening part being bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part

Serial No. 10/532,342  
Docket No. SNK-001-US

17

(IWA.031)

is a matter of design choice. Clearly, this feature has a purpose and may be able to prevent the accumulation of snow.

Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw this rejection.

#### B. The McCoy Reference

To make up for the deficiencies of the alleged Cahoon and Sanko combination, the Examiner applies McCoy. McCoy discloses an improved method for producing a novel type of corrugated metal roofing (McCoy at column 1, lines 1-3). The Examiner alleges that combining McCoy with the alleged Cahoon and Sanko combination makes the invention of claims 4 and 18-23 obvious.

However, Applicant respectfully submits that Sanko, Cahoon, and McCoy would not have been combined. As was previously mentioned, the interval structure of Sanko combined with the clip structure of Cahoon would still leave Cahoon unsatisfactory for its intended purpose and would radically change the principal of operation of Cahoon. As such, McCoy would not overcome Sanko's effect on Cahoon.

Further, even assuming (arguendo) McCoy was combined with the alleged Cahoon and Sanko combination, the resultant combination would still fail to teach or suggest each and every element of the claimed invention. Specifically, McCoy clearly fails to teach an outer surrounding body for use in construction "wherein an edge of an outer end of the fastening part is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part", as recited, for example, in claim 1 (Application at page 23, first paragraph). This feature may provide an outer surrounding body for use in construction which is able to prevent deformation by large accumulations of snow (Application at pages 23, last two lines of page).

Serial No. 10/532,342  
Docket No. SNK-001-US

18

(IWA.031)

The Examiner alleges that reference numeral 11 of McCoy teaches a trough secured to the end of the panel (Office Action at page 7, fourth paragraph). However, McCoy completely fails to teach or suggest an outer surrounding body for use in construction where an edge of an outer end of the fastening part is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part (Application at page 23, first paragraph).

Therefore, even assuming (arguendo) McCoy would have been combined with the alleged Cahoon and Sanko combination, the resultant combination still leaves the deficiencies referenced previously in Section A. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### C. The Greenberg Reference

To make up for the deficiencies of the alleged Cahoon and Sanko combination, the Examiner applies Greenberg. Greenberg discloses a standing seam roofing panel having opposed elevated ridges to define first and second dikes (Greenberg at Abstract). The Examiner alleges that combining Greenberg with the alleged Cahoon and Sanko combination makes the invention of claims 25-28 obvious.

However, Applicant respectfully submits that Sanko, Cahoon, and Greenberg would not have been combined. As was previously mentioned, the interval structure of Sanko combined with the clip structure of Cahoon would still leave Cahoon unsatisfactory for its intended purpose and would radically change the principal of operation of Cahoon. As such, Greenberg would not overcome Sanko's effect on Cahoon.

Further, even assuming (arguendo) Greenberg was combined with the alleged Cahoon and Sanko combination, the resultant combination would still fail to teach or suggest each and every element of the claimed invention. Specifically, Greenberg clearly fails to teach an outer surrounding body for use in construction "wherein an edge of an outer end of the fastening part

Serial No. 10/532,342  
Docket No. SNK-001-US

19

(IWA.031)

is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part", as recited, for example, in claim 1 (Application at page 23, first paragraph). This feature may provide an outer surrounding body for use in construction which is able to prevent deformation by large accumulations of snow (Application at pages 23, last two lines of page).

The Examiner alleges that Figure 5 of Greenberg teaches a seam of a standing seam roof wherein the engaged and engaging parts are recessed toward an inside of the overlapping part into a generally V shape (Office Action at page 12, fifth paragraph). However, Greenberg completely fails to teach or suggest an outer surrounding body for use in construction where an edge of an outer end of the fastening part is bent backward such that the edge of the outer end of the fastening part is parallel with an unbent portion of the fastening part (Application at page 23, first paragraph).

Therefore, even assuming (arguendo) Greenberg would have been combined with the alleged Cahoon and Sanko combination, the resultant combination still leaves the deficiencies referenced previously in Section A. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

#### IV. FORMAL MATTERS AND CONCLUSION

With respect to the Examiner's objections, Applicant respectfully submits that claims 1 and 3 have been amended in a manner fully responsive to the Examiner's objections.

In view of the foregoing, Applicant submits that claims 1 and 3-28, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Serial No. 10/532,342  
Docket No. SNK-001-US

20

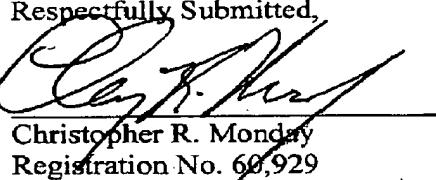
(IWA.031)

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: April 14, 2008

  
Christopher R. Monday  
Registration No. 60,929

Sean M. McGinn  
Registration No. 34,386

**McGinn IP Law Group, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, Virginia 22182-3817  
(703) 761-4100  
**Customer No. 21254**